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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.								
10/067,428	02/07/2002	Masaki Nakai	10270.0001/P001	7889								
<div>7590 08/23/2007 DICKSTEIN SHAPIRO MORIN &amp; OSHINSKY LLP Steven I. Weisburd 41st Floor 1177 Avenue of the Americas New York, NY 10036-2714</div>			<div>EXAMINER OYEBISI, OJO O</div> <table border="1"><thead><tr><th>ART UNIT</th><th>PAPER NUMBER</th></tr></thead><tbody><tr><td>3692</td><td></td></tr></tbody></table> <div><table border="1"><thead><tr><th>MAIL DATE</th><th>DELIVERY MODE</th></tr></thead><tbody><tr><td>08/23/2007</td><td>PAPER</td></tr></tbody></table></div>		ART UNIT	PAPER NUMBER	3692		MAIL DATE	DELIVERY MODE	08/23/2007	PAPER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/067,428

Applicant(s)

NAKAI, MASAKI

Examiner

OJO O. OYEBISI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 05/03/05.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicant's argument in the response dated 06/04/07 to the restriction requirement is persuasive, examiner hereby withdraws the restriction requirement. Claims 1-38 are now pending.

#### ***Specification***

1. The abstract of the disclosure is objected to because of the use of word "therefrom" in the body of the abstract. The use of legal phraseologies should be avoided in the body of the abstract. Correction is required. See MPEP § 608.01(b).

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1-38 recite an online shopping settlement method, however, neither the claims nor the specification mentions the merchant or how the merchant is settled in the online shopping transaction. Although, the applicant states a user terminal, a settlement system, and a web server, and how the user settles the communication carrier (see paras 0110, 0112), but not once explains how the user or the communication carrier settles the merchant. After all, this is online shopping

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method/system, thus a merchant needs to be settled for the product sold to the user/buyer online.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite the limitation "a step wherein said communication common carrier that provides a communication service to said user terminal and collects the price therefor as communication charges, acts as a substitute in respect of a transaction for which the requisite pair of order slip and order confirmation slip are prepared and which transaction is recorded, to collect charges that should be paid by said user terminal to said Web server." This limitation is generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. It is not clear to the examiner what the applicant is trying to claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishimoto ( PUB NO.: 2002/0143648).

**Re claim 1.** Nishimoto discloses an online shopping settlement method wherein both an order slip (i.e., order data, see fig.16 element s100) forwarded from a user terminal to a Web server providing online shopping services (see fig.16) and an order confirmation slip (i.e., order confirmation data, see fig.17 element s200) for confirming receipt of said order slip forwarded from said Web server to said user terminal are detected by a communication common carrier (see fig.17) that provides communication service to said user terminal and collects the price therefor as communication charges, acting as a substitute, in respect of transactions for which said requisite pair of order slip and order confirmation slip are prepared, to collect charges that should be paid by said user terminal to said Web server (see fig.19 elements s406, s408, and s410, also see fig.6)

**Re claim 2.** Nishimoto further discloses an online shopping settlement method that is a settlement method for an online shopping system comprising a user terminal, an Internet service provider connected to said user terminal via a network of a communication common carrier providing communication services to said user terminal and a Web server connected to said Internet service provider via the Internet providing online shopping services for said user terminal (see fig.1), which settlement method includes: (a) a step for detecting an order slip forwarded from said user terminal to said Web server and the corresponding order confirmation slip for confirming receipt of said order slip forwarded from said Web server to said user terminal (see fig.16 and 17); (b)

a step for recording said order slip and order confirmation slip thus detected (see paras 0012); and (c) a step wherein said communication common carrier that provides a communication service to said user terminal and collects the price therefor as communication charges, acts as a substitute in respect of a transaction for which the requisite pair of order slip and order confirmation slip are prepared and which transaction is recorded, to collect charges that should be paid by said user terminal to said Web server (see fig.19 elements s406, s408, and s410, also see fig.6)

**Re claims 3, 4-5.** Nishimoto further discloses an online shopping settlement method according to claim 2, which uses a port number for online shopping especially set for said order slip and order confirmation slip for sending and receiving said order slip and order confirmation slip between said user terminal and said Web server respectively and wherein (i.e., header. Note the message header usually comprises the port number and the ip addresses of the sending host and the destination host, see fig. 7, 9, 11 and 12) at said step (a), a packet among packets going out from said Internet service provider to the Internet which has an online shopping port number is detected as being said order slip and a packet among packets coming into said Internet service provider from the Internet which has an online shopping port number is detected as being said order confirmation slip (see fig.16 and 17)

**Re claims 6 and 7.** Nishimoto further discloses an online shopping settlement method wherein is also included a step (d) that establishes an account-subscriber table holding a list of the relationship between the account name allocated to said user terminal by said Internet service provider and the subscriber line number of said user terminal, that

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accesses said account-subscriber table using the account name of said user terminal that connected to the Internet service provider to retrieve the subscriber line number and then certifies said user terminal that connected to said Internet service provider through checking conditions of said subscriber line (see fig.5)

**Re claims 8, 9-11.** Nishimoto an online shopping settlement method wherein is also included a step (d) that establishes an account-caller table holding a list of the relationship between the account name allocated to said user terminal by said Internet service provider and the calling telephone number of said user terminal, and certifies said user terminal connected to said Internet service provider through checking whether or not the combination of the account name of said user terminal connected to said Internet service provider and the calling telephone number is registered in said account-caller table (see fig.5)

**Re claims 12, 13.** Nishimoto an online shopping settlement method that at said step (c) calculates the online shopping charges that should be collected from said user based on said order slip and order confirmation slip recorded at said step (b) and requests payment therefor together with communication charges when invoicing said user terminal for communication charges (see fig.19 elements s406, s408, and s410, also see fig.6)

**Re claim 14.** Nishimoto further discloses an online shopping settlement system that provides a means for collecting charges in substitute, which means provides an order slip monitoring means for detecting an order slip forwarded from a user terminal to said Web server providing online shopping services and detecting the corresponding order

confirmation slip forwarded from said Web server to said user terminal for confirming receipt of said order slip (see fig.16 and 17), provides an order slip recording means for recording an order slip and order confirmation slip detected by said order slip monitoring means (see paras 0012), which means for collecting charges in substitute is for use by a communication common carrier that provides a communication service to said user terminal and collects the price therefor as communication charges, and which means for collecting charges in substitute acts as a substitute, in respect of a transaction for which the requisite pair of order slip and order confirmation slip are prepared and recorded in said order slip recording means, to collect charges that should be paid by said user terminal to said Web server (see fig.19 elements s406, s408, and s410, also see fig.6).

**Re claim 15.** Nishimoto further discloses an online shopping settlement system that is a settlement system of an online shopping system comprising a user terminal, an Internet service provider connected to said user terminal via a network of a communication common carrier providing communication services to said user terminal and a Web server connected to said Internet service provider via said Internet which server provides online shopping services to said user terminal (see fig. 1), which settlement system includes: an order slip monitoring means for detecting an order slip forwarded from said user terminal to said Web server and detecting the corresponding order confirmation slip forwarded from said Web server to said user terminal for confirming receipt of said order slip (see fig.16 and 17); and an order slip recording means for recording said order slip and order confirmation slip detected by said order slip monitoring means (see paras 0012),; and a settlement means for collecting charges in



substitute that is a means for use by said communication common carrier which means acts as a substitute in respect of a transaction for which said requisite pair of order slip and order confirmation slip are prepared and recorded in said order slip recording means, to collect charges that should be paid by said user terminal to said Web server (see fig.19 elements s406, s408, and s410, also see fig.6).

**Re claims 16, 17-18.** Nishimoto further discloses an online shopping settlement system wherein the configuration is such that a port number for online shopping especially set for said order slip and order confirmation slip is used, facilitating the sending and receiving of said order slip and order confirmation slip between said user terminal and said Web server (i.e., header. Note the message header usually comprises the port number and the ip addresses of the sending host and the destination host, see fig. 7, 9, 11 and 12), and wherein said order slip monitoring means provides a means for detecting those packets among packets going out from said Internet service provider to the Internet which have an online shopping port number as being an order slip and detecting those packets among packets coming into said Internet service provider from the Internet which have an online shopping port number as being an order confirmation slip (see fig. 11, 12, 16 and 17)

**Re claims 19, 20.** Nishimoto further discloses an online shopping settlement system that provides an account-subscriber table holding a list of the relationship between the account name allocated to said user terminal by said Internet service provider and the subscriber line number of said user terminal, and that provides a subscriber certification means that receives from said Internet service provider the account name of said user

terminal that connected to said Internet service provider, accesses said account-subscriber table and retrieves the appropriate subscriber line number and through checking the condition of that subscriber line, certifies said user terminal connected to said Internet service provider (see fig.5)

**Re claims 21, 22-24.** Nishimoto further discloses an online shopping settlement system according that provides an account-caller table holding a list of the relationship between the account name allocated to said user terminal by said Internet service provider and the calling telephone number of said user terminal, and that provides a subscriber certification means that receives from said Internet service provider, the account name of said user terminal that connected to said Internet service provider and the calling telephone number, and through checking whether or not the combination of the account name of said user terminal connected to said Internet service provider and the calling telephone number is registered in said account-caller table, certifies said user terminal that connected to said Internet service provider (see fig.5)

**Re claims 25, 26.** Nishimoto further discloses an online shopping settlement system wherein said settlement means provides a means for calculating the online shopping charges that should be collected from said user based on said order slip and order confirmation slip recorded by said order slip recording means and requests payment therefor together with communication charges when invoicing said user terminal for communication charges (see fig.19 elements s406, s408, and s410, also see fig.6)

**Re claim 27.** Nishimoto further discloses an online shopping settlement program operating a computer forming a settlement system of an online shopping system that

includes a user terminal, an Internet service provider connected to said user terminal via a network of a communication common carrier providing communication services to said user terminal and a Web server connected to said Internet service provider via the Internet which server provides online shopping services to said user terminal, such that said computer functions as: an order slip monitoring means for detecting an order slip forwarded from said user terminal to said Web server and detecting the corresponding order confirmation slip forwarded from said Web server to said user terminal for confirming receipt of said order slip (see fig.16 and 17); an order slip recording means for recording said order slip and order confirmation slip detected by said order slip monitoring means (see paras 0012); and a settlement means for collecting charges in substitute that is a means for use by said communication common carrier which means acts as a substitute in respect of a transaction for which the requisite pair of order slip and order confirmation slip are prepared and recorded in said order slip recording means, to collect charges that should be paid by said user terminal to said Web server (see fig.19 elements s406, s408, and s410, also see fig.6).

**Re claims 28, 29-30.** Nishimoto further discloses an online shopping settlement program facilitating a configuration wherein a port number for online shopping especially set for said order slip and order confirmation slip is used, facilitating the sending and receiving of said order slip and order confirmation slip between said user terminal and said Web server (i.e., header. Note the message header usually comprises the port number and the ip addresses of the sending host and the destination host, see fig. 7, 9, 11 and 12), and facilitating said order slip monitoring means providing a means for

detecting those packets among packets going out from said Internet service provider to said Internet which have an online shopping port number as being an order slip and detecting those packets among packets coming into said Internet service provider from said Internet which have an online shopping port number as being an order confirmation slip (see fig. 11, 12, 16 and 17).

**Re claims 31, 32.** Nishimoto further discloses an online shopping settlement program that operates said computer such that said computer provides an account-subscriber table holding a list of the relationship between the account name allocated to said user terminal by said Internet service provider and the subscriber line number of said user terminal, and such that said computer functions as a subscriber certification means that receives from said Internet service provider the account name of said user terminal that connected to said Internet service provider, accesses said account-subscriber table and retrieves said appropriate subscriber line number and through checking the condition of that subscriber line, certifies said user terminal connected to said Internet service provider (see fig.5)

**Re claims 32, 33-36.** Nishimoto further discloses an online shopping settlement program facilitating operations such that said subscriber certification means provides an IP-subscriber table that stores the relationship between the IP address allocated to said user terminal from said Internet service provider and said subscriber line number while said user terminal is connected to said Internet service provider, and facilitating operations such that said order slip recording means does not record an order slip from among those order slips detected by said order slip monitoring means for which the

subscriber line number corresponding to the source IP address is not registered in said IP-subscriber table and does not record an order confirmation slip from among those order confirmation slips detected by said order slip monitoring means for which the subscriber line number corresponding to the IP address of said user terminal that is the destination is not registered in said IP-subscriber table (see fig.5)

**Re claims 37 and 38.** Nishimoto further discloses an online shopping settlement program facilitating operations such that said settlement means provides a means for calculating the online shopping charges that should be collected from said user based on said order slip and order confirmation slip recorded by said order slip recording means and requests payment therefor together with communication charges when invoicing said user terminal for communication charges (see fig.19 elements s406, s408, and s410, also see fig.6)

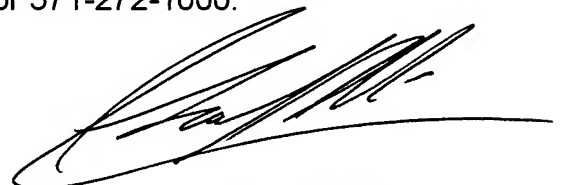
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KAMBIZ ABDI can be reached on (571)272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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